



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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AUG 12 2002

In re

:
:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 CFR 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading her answers to question 21 of the morning session and question 33 of the afternoon session of the Registration Examination held on October 17, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sessions of the Registration Examination. Petitioner scored 68.

On January 18, 2002, petitioner mailed a request for regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers. The directions to the morning and afternoon sessions state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications

for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been granted no additional points on the Examination. No credit has been awarded for morning question 21, and no credit has been awarded for afternoon question 33. Petitioner's arguments for these questions are addressed individually below.

Morning question 21 reads as follows:

21. An inventor, working with prior art subject matter, changes the subject matter, and thereafter files a patent application only claiming the changed subject matter. Which of the following changes might render the claimed subject matter patentable?

- (A) Where the only difference between the prior art device and the claimed device was a recitation of relative dimensions of the claimed device and the claimed device would not perform differently than the prior art device.
- (B) Where the only difference between the prior art device and the claimed device is the configuration of the claimed device, and the configuration is a matter of choice without significance regarding the use of the device.
- (C) Where the difference between the prior art, an impure material, and the claimed subject matter, the purified form of the impure material, is the purity of the material and the utility of the purified material, which differs from the impure material.
- (D) Where the only difference between the prior art device and the claimed device is a reversal of the parts that move relative to each other, and without any unexpected results.
- (E) Where the only difference between the prior art device and the claimed device is elimination of an element and its function, and elimination of the function was desired, required, or expected.

The model answer is selection (C).

21. ANSWER: The most correct answer is (C). MPEP § 2144.04(VII), citing *In re Bergstrom*, 427 F.2d 1394, 166 USPQ 256 (CCPA 1970). (A) is not correct. MPEP § 2144.04(IV)(A), citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). (B) is not correct. MPEP § 2144.04(IV)(B) citing *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). (D) is not correct. MPEP § 2144.04(VI)(A), citing *In re Gazda*, 219 F.2d 449, 104 USPQ 400 (CCPA 1955). (E) is not correct. MPEP § 2144.04(II)(A), citing *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975); and *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989).

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that (E) is the best answer because MPEP 2144.04(II)(A) indicates that "omission of an element and its function is obvious if the function of the element is NOT desired." Petitioner argues that because the word NOT does not appear in answer (E), that choice is patentable. Petitioner has overlooked the word "elimination" in answer (E). Stating that the elimination of a function is desired is equivalent to stating that the function is not desired. For example, in the cases cited in MPEP 2144.04(II)(A), the functions are: 1) the beneficial effects of the polybasic acid salts in a freshwater environment (*Ex parte Wu*), 2) the increased cargo carrying capacity due to the additional framework and axle (*In re Larson*), and 3) the function of the prior art switch member (*In re Kuhle*). Stating that elimination of these functions is desired is equivalent to stating that these functions are not desired. In the absence of a freshwater environment, in the absence of the need to carry a heavy load, or in the absence of a need to have a switch, the above functions become unnecessary, and it may become desirable to eliminate these functions to reduce cost, complexity, or the time required for application or fabrication.

In such a situation, it would have been obvious to one of ordinary skill in the art to eliminate the element providing the function which is desired to be eliminated.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 33 reads as follows:

The following facts pertain to questions 33 and 34.

Applicant Sonny filed a patent application having an effective U.S. filing date of February 15, 2000. The application fully discloses and claims the following:

- Claim 1. An apparatus for converting solar energy into electrical energy comprising:
- (i) a metallic parabolic reflector;
 - (ii) a steam engine having a boiler located at the focal point of the metallic parabolic reflector; and
 - (iii) an electrical generator coupled to the steam engine.

In a non-final Office action dated March 15, 2001, the examiner rejects claim 1 under 35 U.S.C. § 102(d) as anticipated by a patent granted in a foreign country to Applicant Sonny ("Foreign patent"). The Foreign patent was filed February 1, 1999, and was patented and published on January 17, 2000. The examiner's rejection points out that the invention disclosed in the Foreign patent is a glass lens with a steam engine having a boiler at the focal point of the glass lens, and an electrical generator coupled to the steam engine. The rejection states that the examiner takes official notice that it was well known by those of ordinary skill in the art of solar energy devices, prior to Applicant Sonny's invention, to use either a lens or a parabolic reflector to focus solar rays.

33. Sonny informs you that you should not narrow the scope of the claims unless absolutely necessary to overcome the rejection. Which of the following, in reply to the Office action dated March 15, 2001, is best?

- (A) Traverse the rejection arguing that the examiner's use of the Foreign patent is improper because an applicant cannot be barred by a foreign patent issued to the same applicant.

- (B) Amend claim 1 to further include a feature that is disclosed only in the U.S. application, and point out that the newly added feature distinguishes Sonny's invention over the invention in the Foreign patent.
- (C) Traverse the rejection arguing that the examiner does not create a *prima facie* case of obviousness because the examiner does not show why one of ordinary skill in the art of solar energy devices would be motivated to modify the Foreign patent.
- (D) Traverse the rejection arguing that the examiner's rejection under 35 U.S.C. § 102(d) was improper because claim 1 is not anticipated by the Foreign patent.
- (E) Traverse the rejection arguing that it was not well known to use either a lens or a parabolic reflector to focus solar rays, and submit an affidavit under 37 CFR 1.132.

The model answer is selection (D).

33. ANSWER: (D) is the correct answer. MPEP § 706.02 points out the distinction between rejections based on 35 U.S.C. §§ 102 and 103. For anticipation under 35 U.S.C. § 102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. (A), (B), (C), and (E) are each incorrect because each response does not address the lack of anticipation by the Foreign patent. (A) is further incorrect because an applicant can be barred under 35 U.S.C. § 102(d). (B) is further incorrect because the facts do not present the necessity of such an amendment. (C) is further incorrect because a *prima facie* case of obviousness is not necessary in a rejection under 35 U.S.C. § 102.

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that answer (E) is the most correct answer because model answer (D) requires an assumption to be made. Petitioner indicates that an assumption must be made "that the Examiner is incorrect and that the glass lens and parabolic reflector cannot both be used to focus solar rays." There is no need to make such an assumption for model answer (D) to be the most correct answer. To rebut the rejection under 35 U.S.C. § 102(d), it merely needs to be true that the metallic parabolic reflector claimed by the applicant is not anticipated by the glass lens taught in the Foreign patent. Answer (D) is therefore the most correct answer because under 37 CFR 1.111(b), the applicant must point out the supposed errors in the examiner's action and must reply to every ground of

rejection in the Office action. Answer (E) is not the best answer because, even if it were proved that the claimed subject matter was not “well known”, the invention may nonetheless be unpatentable under 35 U.S.C. § 102(d). The loss of right to a patent under 35 U.S.C. 102(d) turns on whether the subject matter was disclosed in the foreign patent, not on how “well known” that subject matter was.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

ORDER

For the reasons given above, no additional points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read "R. Spar", is positioned above the typed name and title of the Director.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy